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MAR 08 2005

## FACSIMILE TRANSMITTAL SHEET

TO: Mail Stop Amendment  
USPTO  
Attn: Examiner Monique R. Jackson  
Group Art Unit 1773

FACSIMILE No.: (703) 872-9306

FROM: Mark L. Warzel  
Reg. No. 47,264

FACSIMILE No.: (650) 330-0980  
TELEPHONE No.: (650) 330-0900

DATE: March 8, 2005

PAGE 1 OF: 6

SUBJECT: U.S. Pat. Appl. Ser. No. 10/774,340  
Filed February 6, 2004

CONFIRMATION COPY TO FOLLOW:

☐ YES ☒ NO

For "PREPARATION OF IMAGES ON A  
SUBSTRATE SURFACE UTILIZING AN  
OPAQUE COATING COMPOSITION  
THAT BECOMES TRANSPARENT UPON  
PRINTING"

By Asutosh Nigam  
Atty Doc. No. 8500-0256.10

Please see the attached **Response to Restriction Requirement** and related transmittal documents for the above-identified patent application.

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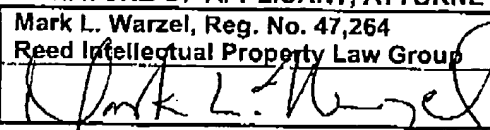
PTO/SB/21 (08-03)

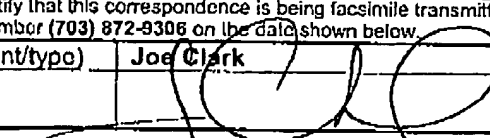
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<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	10/774,340	
	Filing Date	February 6, 2004	
	First Named Inventor	Asutosh Nigam	
	Art Unit	1773	
	Examiner Name	Monique R. Jackson	
Mail Stop	Amendment	Attorney Docket Number	8500-0256.10

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> No fee due <input checked="" type="checkbox"/> Fee Transmittal <input type="checkbox"/> Fee(s) due <input type="checkbox"/> Fee Transmittal <input type="checkbox"/> Check for \$* <input checked="" type="checkbox"/> Charge any underpayment or credit any overpayment to Deposit Account No. 18-0580 <input type="checkbox"/> Return postcard <input checked="" type="checkbox"/> Response to Restriction Requirement <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement & Form(s) PTO-1449 <input type="checkbox"/> Copy(ies) of cited reference(s) <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts / Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s):	<input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks:		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm or Individual Name (print/type)	Mark L. Warzel, Reg. No. 47,264 Reed Intellectual Property Law Group	Telephone	(650) 330-0900
Signature		Date	March 8, 2005

CERTIFICATE OF TRANSMISSION			
I hereby certify that this correspondence is being facsimile transmitted to Examiner Monique R. Jackson in Group Art Unit 1773 of the USPTO at facsimile number (703) 872-9306 on the date shown below.			
Name (print/type)	Joe Clark		
Signature		Date	March 8, 2005

# FEE TRANSMITTAL for FY 2005

Effective 10/01/03. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT \$0.00

## Complete if Known

Application Number 10/774,340  
 Filing Date February 6, 2004  
 First Named Inventor Asutosh Nigam  
 Examiner Name Monique R. Jackson  
 Group Art Unit 1773  
 Attorney Docket No. 8500-0256.10

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None
☒ Deposit Account:

Deposit Account No. 18-0580

Deposit Account Name Reed IP Law Group

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Charge any underpayment or credit any overpayments

☐ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

## 1. BASIC FILING, SEARCH AND EXAMINATION FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	790	2001	395	Utility filing fee (filed on or before 12/8/04)	
1011	300	2011	150	Utility filing fee (filed after 12/8/04)	
1111	500	2111	250	Search Fee	
1311	200	2311	100	Examination Fee	
1091	250	2081	125	For each additional 50 sheets exceeding 100	

SUBTOTAL (1) \$

## 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
62	0		
4	0		

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1202	50	2202	25	Claim in excess of 20	
1201	200	2201	100	Independent claims in excess of 3	
1203	360	2203	180	Multiple dependent claim, if not paid	
1204	200	2204	100	** Reissue independent claims over original patent	
1205	50	2205	25	** Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) \$

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

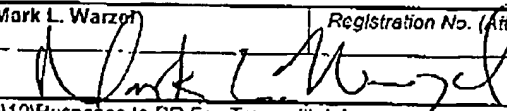
Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1,020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	
1403	1,000	2403	500	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	500	2452	250	Petition to revive - unavoidable	
1453	1,500	2453	750	Petition to revive - unintentional	
1501	1,400	2501	700	Utility issue fee (or reissue)	
1502	800	2502	400	Design issue fee	
1503	1,100	2503	550	Plant issue fee	
1807	50	1807	50	Processing fee under 37 CFR 1.17(a)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
1814	130	2814	65.00	Statutory Disclaimer	

Other fee (specify):

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

## SUBMITTED BY

Name (Print/Type)	Mark L. Warzor	Registration No. (Attorney/Agent)	47,264	Telephone	Complete (if applicable)
Signature				Date	(650) 330-0900
					March 8, 2005

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Response dated March 8, 2005  
Reply to Office Action of February 8, 2005

Atty Dkt No. 8500-0256.10  
SRI No. US 4033-3

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**MAR 08 2005**

In re Application of:

Asutosh Nigam

Confirmation No. 5320

Serial No.: 10/774,340

Group Art Unit: 1773

Filing Date: February 6, 2004

Examiner: Monique R. JACKSON

Title: PREPARATION OF IMAGES ON A SUBSTRATE SURFACE UTILIZING AN OPAQUE COATING COMPOSITION THAT BECOMES TRANSPARENT UPON PRINTING

**RESPONSE TO REQUIREMENT FOR RESTRICTION AND ELECTION OF SPECIES**

Commissioner for Patents  
Washington, DC 20231

Sir:

This is in response to the Office Action mailed February 8, 2005. In the Office Action, restriction between the following two groups of claims has been required:

- I. Claims 1-40 and 47-55, drawn to a process for producing an image; and
- II. Claims 41-46 and 56-62, drawn to a coated substrate.

A species election has also been required from among the following claimed opaque coating compositions:

1. The combination of a monomeric polyacid and a monomeric polybase;
2. The combination of a monomeric polyacid and a polymeric polybase; and
3. The combination of a polymeric polyacid and a monomeric polybase.

A further election of particular species compounds has also been required for each of the monomeric polyacid, polymeric polyacid, monomeric polybase, and polymeric polybase.

**Response to Restriction Requirement:**

Applicant elects Group I, claims 1-40 and 47-55, with traverse.

Applicant respectfully traverses the Restriction Requirement since the reasons cited in the Office Action do not support the statement that the "product as claimed can be made by another and materially different process" (emphasis added). In fact, no actual reference to such a hypothetically "materially different process" is even cited in the Office Action. Instead, only a reference to the product not requiring a recording liquid is mentioned.

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Response dated March 8, 2005  
Reply to Office Action of February 8, 2005

Applicant also respectfully submits that the reasoning provided in the Office Action is not pertinent to establishing support for the Restriction Requirement. In particular, as claimed, the coated substrate "becomes partially or entirely transparent upon contact with a recording liquid," while the claimed process comprises "contacting the coated substrate with a recording liquid that renders the opaque coating partially or entirely transparent". Since both the process and the product refer to the same characteristic provided to the coated substrate (i.e., the same substrate coated with the same claimed opaque coating composition), no apparent distinction exists to warrant separating the claimed product from the process that produces such a product. In short, within the context of the language utilized in the claims, there is no "materially different process" that could be utilized to produce the product having the claimed characteristic. At the very least, no such process has been mentioned in the Office Action to support the grounds relied upon for Restriction.

For at least the foregoing reasons, withdrawal of the Restriction Requirement is requested.

**Response to Election of Species Requirement:**

Applicant elects the species wherein the opaque coating composition comprises a monomeric polyacid and a monomeric polybase.

Applicant further elects the species wherein the monomeric polyacid is a carboxylic acid containing compound. For the purposes of conducting the initial search and examination only, applicant selects the dicarboxylic acid compound maleic acid.

Applicant further elects the species wherein the monomeric polybase is an amine containing compound. For the purposes of conducting the initial search and examination only, applicant selects the diamine compound ethylenediamine.

It is assumed that an election of the polymeric polyacid and polymeric polybase is not required in light of the above election of the monomeric species noted above. However, should the Examiner require such an election, applicant selects poly(acrylic acid) as the polymeric polyacid and polylethylencimine as the polymeric polybase.

Within Group I, claims 1-40 and 47-55 are generic to an opaque coating composition that comprises the elected monomeric polyacid and the monomeric polybase. In addition, claims 1-9, 21-40, and 47-55 are believed to read on the elected process in which the claimed opaque coating composition includes a monomeric polyacid and a monomeric polybase, without positively reciting the presence of a polymeric polyacid and/or polymeric polybase (although these components may generally also be present within the scope of the claims).

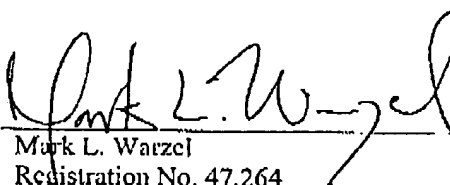
Applicant notes this election of species and ultimate species is for the sole purpose of the carrying

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Response dated March 8, 2005  
Reply to Office Action of February 8, 2005

out the initial search and examination of the claims, and that upon allowance of a generic claim, applicant is entitled to have all non-elected species encompassed by that claim examined (37 C.F.R. 1.141).

Should the Examiner have any questions concerning this response, or wish to discuss the application as the search and examination are initiated, a telephone call to the undersigned at (650) 330-0900 would be appreciated.

Respectfully submitted,

By:   
Mark L. Warzel  
Registration No. 47,264

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